

**O-514-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3303514  
BY INNORBIT LIMITED TO REGISTER THE TRADE MARK**

**ayurvedic up&go**

**IN CLASS 5**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 413046 BY  
AUSTRALASIAN CONFERENCE ASSOCIATION LIMITED**

## BACKGROUND AND PLEADINGS

1) Innorbit Limited (hereafter “the applicant”) applied to register the mark “ayurvedic up&go”. The relevant dates and list of goods are:

Filing date: 12 April 2018

Publication date: 11 May 2018

**Class 5:** *Fiber (Dietary -); Fibre (Dietary -); Food for medically restricted diets; Food supplements; Food supplements consisting of amino acids; Food supplements consisting of trace elements; Food supplements for dietetic use; Food supplements for medical purposes; Food supplements for non-medical purposes; Foodstuffs for diabetics [specially made for].*

2) Australasian Conference Association Limited (hereafter “the opponent”) opposes the application. The opposition is based upon section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following four marks when challenging the application (with the goods shown in bold being those in which a reputation is claimed for the purposes of section 5(3)):

<b>European Union Trade Mark (EUTM) No. 12334462</b>
UP&GO & OATS Filing date: 22 November 2013 Registration date: 14 May 2014
The list of goods:  <b>Class 29:</b> <i>Milk and milk products; milk based beverages; dairy substitutes in this class being milk beverages and milk products derived from plant sources including soy beans, almonds and rice; eggs; prepared nuts; nut and seed spreads; nut butters; jellies; jams; compotes; edible oils and fats; snack foods in this class; <b>cooked, dried, frozen or preserved fruits</b>; cooked, dried, frozen or preserved vegetables; cooked, dried, frozen or preserved meals; food products in this class containing or made from vegetables or fruits; <b>mixtures in this class comprised primarily of dried fruits, prepared nuts, seeds, milk products including yogurt, dairy substitutes in this class or any combination of the foregoing</b>; soups; preparations for making soups; meat; fish;</i>

poultry; game; meat extracts; **food preparations with added vitamins and minerals in this class**; milk and milk substitute based snacks; milk and substitutes therefor; milk products and substitutes therefor; dairy products and substitutes therefor; soy based milk and dairy substitutes; soy milk; soy milk extracts; soy milk products.

**Class 30: Cereal products and cereal based beverages in this class; cereals and products made from or containing cereals including breakfast cereals; food beverages in this class**; bread; pastry products; biscuits; cookies; crackers; rice cakes; rice products; rice milk; soy-based products; confectionery; **energy bars; snack foods in this class**; ice cream; frozen yogurt; custard; ices; ice; sauces (condiments); mustard; seasonings spices; flavourings; flavourings for beverages; coffee; artificial coffee; tea; cocoa; chocolate-based beverages; cocoa-based beverages; coffee-based beverages; sugar; honey, treacle; golden syrup; yeast; baking powder; **cereal based snack foods; cereal based snack bars**; muesli based snack foods; muesli based snack bars; preserved herbs; fruit sauces.

**Class 32: Non-alcoholic beverages**; soy-based beverages; **cereal-based beverages; beverages containing cereal, soy and dairy milk**; syrups and other preparations for making beverages.

#### International Registration designating the EU (IREU) No. 1267718



Date of designating of the EU: 13 February 2015

Priority date: 21 October 2014

Date protection granted in EU: 10 August 2016

The list of goods:

**Class 29: Milk; milk based beverages; milk products**; soya milk; flavoured and unflavoured whole soya bean milk; **flavoured and unflavoured soya-derived beverages and foodstuffs in the nature of milk**; soya based food beverage used as a milk substitute; **dairy substitutes included in this class being milk beverages and milk products derived from plant sources including soya beans, almonds and rice**; eggs; prepared nuts; nut and seed spreads; nut butters; jellies; jams; compotes; edible oils and fats; **snack foods consisting primarily of meat, fish, poultry, vegetables or fruits; cooked, dried, frozen or preserved fruits**; cooked, dried, frozen or preserved

vegetables; cooked, dried, frozen or preserved meals consisting primarily of meat, fish, poultry, vegetables or fruit; **food products included in this class containing or made from vegetables or fruits; mixtures included in this class comprised primarily of dried fruits, prepared nuts, seeds, milk products including yoghurt, dairy substitutes in this class or any combination of the foregoing; soups; preparations for making soups; meat; fish; poultry; game; meat extracts.**

**Class 30: Cereals and products made from or containing cereals including breakfast cereals and substitutes therefor, and preparations and extracts made therefrom; drinks made from cereals; bread; pastry products; biscuits; cakes; cookies; crackers; rice cakes; confectionery; energy bars consisting primarily of grains and cereals; cereal derived food bars; snack foods consisting primarily of grains; cereal based snack food; ice cream; frozen yogurt; custard; ices; ice; fruit sauces; sauces (condiments); mustard; seasonings; spices; preserved herbs (seasonings); flavourings; flavourings for beverages (terms considered too vague by the International Bureau - rule 13.2.b) of the Common Regulations); coffee; artificial coffee; tea; cocoa; sugar; honey, treacle; golden syrup; yeast; baking powder; full fat, low fat and fat-free plain chocolate, coffee, vanilla, strawberry, banana and supplemented soya-bean derived beverages.**

**Class 32: Non-alcoholic beverages including cereal based beverages also containing soya and dairy milk; mineral and aerated water and other non-alcoholic drinks; fruit- and other-based syrups, and other preparations for making beverages; soft drinks and fruit juices; soya-based beverages with or without fruit or vegetable juices or extracts; plain and fortified soya-bean derived beverages.**

**EUTM No. 4804225**

UP&GO

Filing date: 14 December 2005

Registration date: 2 March 2007

The list of goods relied upon:

**Class 29: Milk; milk based beverages, food products...; flavoured and unflavoured soya-derived beverages and foodstuffs in the nature of milk; ...; dairy substitutes in this class being milk beverages and milk products derived from plant sources including soya beans, almonds and rice...; snack foods in this class; ...; food products in this class containing or made from vegetables or fruits; mixtures in this class comprised primarily of dried fruits, prepared nuts, seeds, milk products including yogurt, dairy substitutes in this class or any combination of the**

*foregoing; ...*

**Class 30: Cereals and products made from or containing cereals including breakfast cereals and substitutes therefor, and preparations and extracts made therefrom; drinks made from cereals; ...; energy bars; cereal derived food bars; snack foods in this class; cereal based snack food; ...; full fat, low fat and fat-free plain, chocolate, coffee and supplemented soya-bean derived beverages.**

**Class 32: Non-alcoholic beverages including cereal based beverages also containing soya and dairy milk; ... other non-alcoholic drinks; ...**

**UK Trade Mark (UKTM) No. 2431016**

UP&GO/Up&Go/up&go (series of 3 marks)

Filing date: 25 August 2006

Registration date: 13 July 2007

The list of goods:

**Class 29: Milk; milk based beverages, food products; milk products; soya milk; flavoured and unflavoured whole soya bean milk; flavoured and unflavoured soya-derived beverages and foodstuffs in the nature of milk; soya based food beverage used as a milk substitute; full fat, low fat and fat-free plain, chocolate, coffee, vanilla, strawberry, banana and supplemented soya-bean-derived beverages; soya-based beverages with or without fruit or vegetable juices or extracts; plain and fortified soya-bean derived beverages; dairy substitutes in this class being milk beverages and milk products derived from plant sources including soya beans, almonds and rice; eggs; prepared nuts; nut and seed spreads; nut butters; jellies; jams; compotes; edible oils and fats; snack foods in this class; preserved herbs; cooked, dried, frozen or preserved fruits; cooked, dried, frozen or preserved vegetables; cooked, dried, frozen or preserved meals; food products in this class containing or made from vegetables or fruits; mixtures in this class comprised primarily of dried fruits, prepared nuts, seeds, milk products including yoghurt, dairy substitutes in this class or any combination of the foregoing; soups; preparations for making soups; meat; fish; poultry; game; meat extracts.**

**Class 30: Cereals and products made from or containing cereals including breakfast cereals and substitutes therefor, and preparations and extracts made therefrom; drinks made from cereals; bread; pastry products; biscuits; cakes; cookies;**

*crackers; rice cakes; confectionery; **energy bars; cereal derived food bars; snack foods in this class; cereal based snack food**; ice cream; frozen yogurt; custard; ices; ice; fruit sauces; sauces (condiments); mustard; seasonings; spices; flavourings; flavourings for beverages; coffee; artificial coffee; tea; cocoa; sugar; honey, treacle; golden syrup; yeast; baking powder; **full fat, low fat and fat-free plain chocolate, coffee, vanilla, strawberry, banana and supplemented soya-bean derived beverages.***

**Class 32: Non-alcoholic beverages including cereal based beverages also containing soya and dairy milk;** *mineral and aerated water and other non-alcoholic drinks; fruit- and other-based syrups, and other preparations for making beverages; soft drinks and fruit juices.*

3) The opponent's marks are all earlier marks within the meaning of section 6(1) of the Trade Marks Act 1994 ("the Act") because they have filing dates/dates of designation earlier than the filing date of the contested application. Two of the earlier marks (EUTM 4804225 and UKTM 2431016) completed their registration procedures more than five years before the publication date of the contested application and, as a result, they are potentially subject to the proof of use provisions contained in section 6A of the Act. The two other earlier marks (EUTM 12334462 and IREU 1267718) are not subject to the proof of use provisions.

4) The opponent asserts that registration of the contested application would be contrary to section 5(2)(b) of the Act because the term "ayurvedic", present in the applicant's mark, is descriptive and because both the applicant's and opponent's marks share the term UP&GO. It asserts that the distinctive element of all the respective marks is UP&GO and that both parties' marks are in respect of highly similar goods.

5) In respect of the grounds based upon section 5(3) of the Act, the opponent asserts that the similarity between the parties' marks would cause the relevant public to believe that there is an economic connection between the parties and use of the applicant's mark in respect of similar and/or complementary goods would, without due cause:

- take unfair advantage of both the distinctive character and reputation of the opponent's marks because the consumer will assume that the parties' respective goods have the same commercial origin and that the applicant would benefit from the opponent's mark's reputation. This may result in a diversion of sales from the opponent to the applicant;
- be detrimental to the reputation of the opponent's marks. The opponent states that it is highly regarded in the field of liquid breakfast and nutritional products and where the consumer is deceived as to the origin of the goods, the opponent will be prevented from maintaining the integrity of its customer base and will suffer loss of sales;
- be detrimental to the distinctive character of the opponent's marks because use of the applicant's mark will dilute its distinctive character and its ability to identify the origin of the goods for which it is registered.

6) The applicant filed a counterstatement denying the claims made and requesting that the opponent provide proof of use of the goods in Class 5 covered by the earlier 4804225 and 2431016 marks. The opponent does not rely upon any Class 5 goods in respect of these marks, therefore, the request for proof of use has no impact upon these proceedings and it is not necessary for me to comment further on this issue.

7) The opponent filed evidence and the applicant filed written submissions. I will refer to these to the extent that I consider it necessary. No hearing was requested but both sides provided written submissions in lieu, and I also keep these in mind. I take this decision after careful consideration of the papers.

### **Opponent's Evidence**

8) This takes the form of a witness statement by Ben Weeks, Head of Sales of Life Health Foods UK Limited, the licensee of the UP&GO brand in the UK and Europe. He is authorised to speak on behalf of the opponent. The purpose of his evidence is to demonstrate the scope and extent of use of the opponent's marks in the UK and Europe.

## **DECISION**

### **Section 5(2)(b)**

9) Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

### ***Comparison of goods and services***

10) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

11) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;



- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

12) The opponent submits that the applicant's goods can be categorised as food supplements and that these are highly similar to its goods. I agree that most of the applicant goods are food supplements but not all. The exceptions are *Food for medically restricted diets* and *Foodstuffs for diabetics [specially made for]* which are foods that mirror everyday foodstuffs but are adapted in some way to make them suitable for consumers on medically restricted diets. Consequently, the opponent's comments do not apply to such terms.

13) In respect of the applicant's various supplements the opponent identified the following examples from its goods that it submits are highly similar: *milk products derived from plant sources including soya beans, almonds and rice* in Class 29, *full fat, low fat and fat-free plain chocolate, coffee, vanilla, strawberry, banana and supplemented soya-bean derived beverages* and *Non-alcoholic beverages including cereal based beverages also containing soya and dairy milk*. In support of this submission it draws attention to three decisions. The first of these is UKIPO decision *U Fit Group Limited v Icon Health & Fitness Inc*, BL O-013-19 where the hearing officer expressed her view as follows:

"51. All of the applicant's class 5 goods are nutritional or dietary supplements in the form of "bars, gels, beverages and pharmaceutical preparations for making beverages". In my view, the opponent's best case in respect of these goods lies in its goods in classes 29, 30 and 32. For example, there will be some similarity in nature and method of use between these goods and the opponent's "non-alcoholic drinks" and "flour and preparations made from cereals, bread, pastry and confectionary, ices". There may be some overlap in users for these goods on a general level as they will all be used by members

of the general public and they may be available generally in the same retail outlets (such as supermarkets). The intended purposes of these goods are different as the applicant's goods will be used for the specific dietary or nutritional purposes for which they are designed. In my view, there is a medium degree of similarity between the applicant's class 5 goods and the opponent's goods."

14) I agree with the hearing officer in that case, and I reject the opponent's assertion that the respective goods are "highly similar". I find that the applicant's various supplements share a medium degree of similarity with the example goods identified by the opponent.

15) The other two decisions are presented by the opponent as being EUIPO Opposition decisions: *R. Seelig & Hille oHG v Bioherba R*, No. 002679267 and *Central de Distribucio Htelera Serhs, S. L. v Kama International Oy*, No. B267927. I note that the same number has been given regarding both decisions, but in light of my comments in the previous paragraph, it is not necessary to explore the comments in these decisions.

16) In respect of the applicant's remaining goods, namely, *Food for medically restricted diets* and *Foodstuffs for diabetics [specially made for]*, the considerations are slightly different. When compared to the opponent's Class 29 and Class 30 goods, they will overlap significantly in terms of nature (all being foodstuffs), purpose (to satisfy hunger) and method of use (all being consumed orally). Trade channels are becoming more similar with foods for medically restricted diets becoming more readily available in ordinary grocery stores, even if they are normally displayed on different shelves. They are not complementary in the sense that one is "indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking"<sup>1</sup> but there may be an element of competition where, for example, a diabetic may be able to choose between a food product adapted for their needs or an ordinary version of

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<sup>1</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

the same product. Taking all of this into account, I conclude the level of similarity is somewhere between medium and high.

**Comparison of marks**

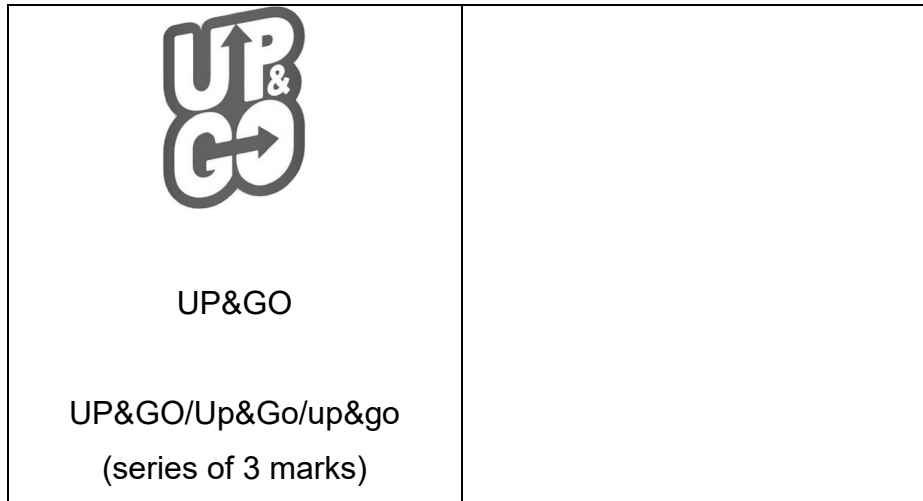
17) It is clear from *Sabel BV v. Puma AG*, Case C-251/95 (particularly paragraph 23), Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

18) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take account of the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

20) The respective marks are:

Opponent's marks	Applicant's mark
UP&GO & OATS	ayurvedic up&go



19) It is clear to me that the opponent's third and fourth marks offer its strongest case because they consist only of the elements UP&GO in ordinary typeface and no additional matter that would introduce differences when compared to the applicant's mark. Therefore, for procedural economy, I will restrict my considerations to the similarity of the applicant's mark to the opponent's "up&go" mark. If the opposition based on section 5(2)(b) cannot succeed when based upon this mark, it will not succeed in respect of any of the other of the opponent's marks.

20) The opponent's mark consists of the three elements "up", "&" and "go" conjoined. This creates a single term that imparts the distinctive character upon the mark. The applicant's mark consists of the word "ayurvedic" together with the same term that the opponent's mark consists and presented in an identical conjoined way. The opponent submits that the term "ayurvedic" is descriptive because it indicates something related to "Ayurveda", the traditional Hindu system of medicine. It provides no evidential support for this submission, however, the meaning of "Ayurveda" is confirmed by reference to the online Oxford dictionary<sup>2</sup>. Therefore, I do not doubt the meaning of the word. However, it is not obvious to me that the UK average consumer will be aware of such a meaning and there is no evidence to indicate that this is the case. The mere existence of a dictionary reference is insufficient to establish this<sup>3</sup>. Consequently, I am unable to conclude that such a

<sup>2</sup> <https://www.lexico.com/en/definition/ayurveda>

<sup>3</sup> See to this effect, the decision of Ms Carboni, sitting as the Appointed Person in *CHORKEE Trade Mark*, paragraph 37, BL O-048-08

meaning will be perceived and, therefore, the word will retain a distinctive role within the mark and will share at least an equal dominance with the term “up&go”.

21) Visually, both marks share the identical “up&go” element, but they differ in that the applicant’s mark includes the additional element “ayurvedic” appearing at the start. As it appears at the beginning of the mark, its visual impact is increased so that the level of similarity is medium.

22) From an aural perspective, the marks share the three syllables UP, AND and GO, but differ in that the applicant’s marks also includes the four syllables AY-UR-VED-IC. Taking this into account, the aural similarity is medium.

23) Conceptually, the common element “up&go” may be perceived in a number of different ways, but it is most likely to be perceived as a phrase to describe the effects of the goods sold under the mark, namely, that they will help the user to get up and go or give them some get up and go. Therefore, the term alludes to the parties’ goods imparting energy to the user. As I have already discussed, the average consumer is not likely to attach any meaning to the word “ayurvedic”. Taking all of this into account, I conclude that the respective marks share a medium to high level of conceptual similarity.

### ***Average consumer and the purchasing act***

24) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

25) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

26) The relevant average consumer of the respective goods is likely to be an ordinary member of the public either with or without specific dietary requirements. In respect of the level of care and attention paid during the purchasing act, this is likely to range from average in respect of ordinary food or drink items to slightly elevated in respect of food supplements and foods for those with specific dietary requirements because, in these circumstances, the consumer will pay more attention to ensure that the product selected meets their specific dietary needs. In all cases, visual impressions are likely to be important but I do not ignore that aural considerations may play a part in the purchasing process where the consumer may aurally request the goods.

### ***Distinctive character of the earlier trade mark***

27) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

28) I begin by considering the mark’s inherent level of distinctive character. It consists of the term “up&go” and, as I have already commented, it creates an allusion to the effect of the goods sold under the mark, namely, that they provide energy to the user i.e. to help them to get up and go. Consequently, the mark is not endowed with a particularly high level of inherent distinctive character that may reside in an invented word, for example. Nevertheless, I conclude that it has a medium level of inherent distinctive character.

29) The opponent claims that its marks enjoy an enhanced level of distinctive character because of the “significant level of use”. Mr Weeks’ evidence, provided on behalf of the opponent, illustrates the following:

- The opponent’s mark was launched in the UK in February 2015 with the accompanying marketing campaign costing £1.1 million and included television advertising as well as digital and social media advertisements<sup>4</sup>;
- Photographs of the opponent’s liquid breakfast products appearing on shop shelves<sup>5</sup> (stated to be Tesco, Asda, Morrisons, Sainsburys, WHSmith and Bestway<sup>6</sup>) are provided and show its stylised mark (corresponding to its IREU) appearing on the packaging. Further, a screen shot stated<sup>7</sup> to be from

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<sup>4</sup> Mr Weeks’ witness statement, para. 6

<sup>5</sup> Exhibits BW3, BW4, BW6 – BW9

<sup>6</sup> Mr Weeks’ witness statement, para. 7

<sup>7</sup> ditto

the online retailer Ocado shows similar products offered for sale under the same stylised mark and with additional descriptions using the word mark “Up&Go”<sup>8</sup>;

- a media campaign run in August – October 2018. However, because this is after the relevant date in these proceedings (the filing date of the contested mark, namely 12 April 2018) it does not advance the opponent’s case;
- the opponent’s “up&go” products are marketed on the website [www.upandgo.co.uk](http://www.upandgo.co.uk) that received 146,000 visits between 1 January 2015 and 18 December 2018<sup>9</sup>. Promotion has also taken place on Facebook (10,000 followers) and Twitter (nearly 2000 tweets)<sup>10</sup>;
- Total gross sales in the UK for the 12 months prior to 31 July 2018 was approximately £3.5 million<sup>11</sup>.

30) Whilst the way the evidence has been presented often results in it not being possible to ascertain the exact extent of the use and promotion of the opponent’s mark as of the relevant date of 12 April 2018, it still provides a rough indication. However, there is no indication of market share, what proportion of the relevant section of the public identify the opponent’s goods as coming from a particular undertaking or any evidence from the trade. Consequently, it is not possible to place the use shown in context. The evidence does show that goods bearing the opponent’s mark have been/are available through many of the prominent supermarkets in the UK. Taking all of this into account, if the distinctive character of the opponent’s mark is enhanced through use (in respect of liquid breakfast products), it is no more than a low level of enhancement.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion**

31) The following principles are obtained from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-

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<sup>8</sup> Exhibit BW5

<sup>9</sup> Mr Weeks’ witness statement, para. 9

<sup>10</sup> Ditto. Both the Facebook and Twitter statistics were taken as of December 2018, i.e. some 8 months after the relevant date

<sup>11</sup> Ditto, para. 10



342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

32) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

33) I have found that:

- In respect of the applicant's food supplements, they share a medium degree of similarity to the opponent's goods. In addition, I found that the applicant's remaining goods share a medium to high level of similarity to the opponent's goods;

- Both elements play a distinctive role in the applicant's mark and that the opponent's mark will be perceived as a single term and it is this term, as a whole, that imparts distinctive character;
- The respective marks share a medium level of visual and aural similarity and a medium to high level of conceptual similarity;
- The average consumer is likely to be ordinary members of the public with or without specific dietary requirements. The degree of care and attention paid during the purchasing act will vary from average in respect of ordinary food and drink items, to slightly elevated in respect of food supplements and foods for those with specific dietary requirements. The purchasing process is likely to be visual, but I recognised that aural considerations may play a part;
- The opponent's mark has a medium level of inherent distinctive character and that it has no more than a low level of enhancement because of the use made of it.

34) Taking account of all of the above, whilst the slightly increased level of care and attention applied during the purchasing of the applicant's goods leans slightly in favour of no likelihood of confusion, this is easily outweighed by a combination of the reasonable levels of similarity that exists between the goods and marks and the fact that the purchasing process is primarily visual in nature and the consumer will readily see the identical element "up&go" in both marks. Whilst the addition of the word "ayurvedic", present in the applicant's mark, is not likely to go unnoticed (and therefore, there is no likelihood of direct confusion, where one mark is confused with the other) there is, nonetheless, a likelihood of indirect confusion where the consumer is likely to believe that the goods sold under the respective marks originate from the same or linked undertakings.

35) In summary, the opposition based upon section 5(2)(b) succeeds in respect of all of the applicant's goods.

36) My conclusion does not require that the opponent's mark benefits from enhanced distinctive character, a conclusion that is not obvious from the evidence provided.

37) My findings are based upon the opponent's "up&go" mark that is one of the three marks in the series of marks covered by its earlier UKTM 2431016. It is also my view that the opponent is equally successful when relying upon the other two marks in that series and its EUTM 4804225. In respect of these other earlier marks, they differ from the applicant's mark only in that they are presented in either uppercase letters or with an uppercase first letter of each of the words "Up" and "Go". It is generally accepted that a mark represented in lower case, uppercase or with uppercase first letters is protected for any of these representations. Therefore, in effect they are also identical to an element of the applicant's mark. In respect of the opponent's UP&GO & OATS (EUTM 12334462) and UP&GO (word and device - IREU 1267718), whilst the elements of these marks that are absent in the applicant's mark are additional factors that weigh more against a finding of a likelihood of confusion, it is my view that these are still insufficient to overcome the reasonable level of similarity between the marks and goods and that a likelihood of indirect confusion exists here also.

### **Section 5(3)**

38) In light of my finding it is not strictly necessary for me to also comment upon the ground based upon section 5(3) of the Act, but I will do so briefly.

39) Section 5(3) states:

"(3) A trade mark which –

- (a) is identical with or similar to an earlier trade mark,
- (b) (repealed)

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EU) in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

40) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the

goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

## **Reputation**

41) In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

42) The relevant date for assessing if the opponent has a necessary reputation is the filing date of the contested application, namely, 12 April 2018. When considering whether the opponent's mark benefitted from an enhanced level of distinctive character, I concluded that if it was, it was no more than a low level of enhancement. This was because the evidence provided attracted some criticisms such as there being no indication of market share, no evidence from the trade, and neither was the evidence directed to the position as at the relevant date, making an accurate assessment difficult. If it is assumed that the turnover was in the region of £3.5 million for the year ending on the relevant date, there is no indication of the turnover in previous years. Further whilst there was a television promotional campaign at the time of the UK launch in February 2015, there are no details regarding the reach such a campaign had, or even on what television channels such promotion occurred. Taking all of this into account, whilst there has clearly been use in the UK between February 2015 and April 2018, I cannot conclude that such use has been at a level that has resulted in the requisite reputation. To provide evidence of such a reputation would have been relatively easily obtained by the opponent, but it has failed to do so.

43) In summary, I conclude that the opponent has failed to demonstrate that it has the requisite reputation amongst a significant part of the public concerned.

44) In light of my finding, without the requisite reputation, the claim based on 5(3) falls at the first hurdle.

45) The ground based upon section 5(3) fails in its entirety.

### **Summary**

46) The opposition succeeds, based upon section 5(2)(b), in respect of all of the goods claimed and, subject to any successful appeal, the application will be refused in its entirety.

### **Costs**

47) As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent costs as a contribution towards the costs of the proceedings, as follows:

Preparing a statement and considering the applicant's statement (including official fee)	£500
Preparing evidence and considering the applicant's submissions	£700
Written submissions (in lieu)	£400
<b>Total</b>	<b>£1,600</b>

48) I therefore order Innorbit Limited to pay Australasian Conference Association Limited the sum of £1,600. This sum should be paid within 14 days of the expiry of



the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated 3 September 2019**

**Mark Bryant**

**For the Registrar**

**The Comptroller-General**